



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,103	03/16/2001	James A. Johanson	A2550.0002/P002	8930

24998 7590 04/24/2003

DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
2101 L STREET NW
WASHINGTON, DC 20037-1526

EXAMINER

WEAVER, SCOTT LOUIS

ART UNIT	PAPER NUMBER
----------	--------------

2645

DATE MAILED: 04/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,103

Applicant(s)

JOHANSON ET AL.

Examiner

Scott L. Weaver

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-23 and 25-36 is/are rejected.
- 7) ☒ Claim(s) 3 and 24 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2645

Part III Detailed Action

Claim Rejections - 35 U.S.C. § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 35 (ln.3) "said extension telephone link" lacks positive antecedent basis.

Claim Rejections - 35 U.S.C. § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Art Unit: 2645

4. Claims 27-32, and 35-36 are rejected under 35 U.S.C. 102(a) as being clearly anticipated Bertocci et al. (#6, 148,213).

Bertocci teaches a main telephone answering device with control circuit and transceiver circuitry to communicate wirelessly with an extension answering device having second control and transceiver circuitry via (figure 4-6; col.1,ln.33-col.2,ln.3; col.2,ln.54-col.3,ln.11; col.3,ln.51-col.4,ln.6; col.4,ln.30-col.5,ln.16; col.9,ln.5-14). The extension device is enabled to screen incoming calls answered by the main unit without user intervention, as well as enabled to interrupt screened calls being monitored so that message recording will stop as well as enabled to control all of the functions of the main answering unit from the extension device.

5. Claims 1-2, 4-9, 13-18, 20-23, 27-32, and 35-36 are rejected under 35 U.S.C. 102(a) as being clearly anticipated Kite (#6,104,923).

Kite clearly teaches via (for example coll.13,ln.7-50; col.14,ln.5-26) the remote controller extension answering device with a main answering device communicating wirelessly therewith to screen incoming calls and control the main answering unit as claimed.

Claim Rejections - 35 U.S.C. § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 12,25-26, 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kite in view of Ekel et al. (#US2002/0002707).

Kite clearly teaches that which is pointed out above as pertains to claims 1, 13, and 27 from which claims 12,25-26, 33-34 depend.

Kite does not teach the use of a Bluetooth compliant communication for the wireless communication between the extension and main unit as per claims 12,25-26, 33-34.

Ekel teaches to use Bluetooth compliant wireless transmission for a remote control of a main device for control of audio, (Paragraphs [0023-0025]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Bluetooth compliant wireless transceiver and control circuitry as taught by Ekel for use in the remote control of Kite for the reason that Bluetooth is a preferred wireless technology due to ready availability of components for use with therewith.

Art Unit: 2645

8. Claims 10-11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kite in view of Sacher et al. (WO 94/27394).

Kite does not teach one of the functions of the answering machine is to be able to transfer messages to other of multiple mailboxes define in the main answering unit.

Sacher teaches to enable a user to transfer a message to an alternative mailbox of multiple mailboxes on the main unit via (page 13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the main answering unit of Kite to include a command accessible to remote as well as main unit such that multiple mailboxes for users were provided and the command could enable the transfer of messages amongst mailboxes as taught by Sacher for the purpose of enabling multiple users to receive private messages and to transfer desired messages to other persons associated therewith as desired.

Conclusion

9. The prior art made of record and not relied on is considered pertinent to the claimed subject matter, the prior art of record at this time does not clearly teach or fairly suggest to one of ordinary skill in the art that which is as provided via claims 3 and 24 including the combination as claimed and those claims would be allowable if rewritten to include the limitations of the base and intervening claims.

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

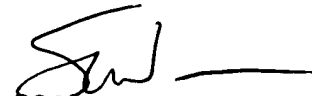
(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Weaver whose telephone number is (703) 308-6974. The examiner can normally be reached on Monday through Friday from 8:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4750 or to 2600 Customer Service at 703-306-0377.


SCOTT L. WEAVER
PRIMARY EXAMINER
Art Unit 2645